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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re United States Patent Application of:		**Docket No.:**	**2771-510 CIP**
Applicants:	**Thomas H. Baum, et. al.**	**Conf. No.:**	**8827**
Application No.:	**09/954,831**	**Art Unit:**	**1762**
Date Filed:	**September 18, 2001**		
Title:	**SOURCE REAGENT COMPOSITIONS FOR CVD FORMATION OF GATE DIELECTRIC THIN FILMS USING AMIDE PRECURSORS AND METHOD OF USING SAME**	**Cust. No.:**	**25559**

EXPRESS MAIL CERTIFICATE

I hereby certify that I am mailing the attached documents to the Commissioner for Patents on the date specified, in an envelope addressed to the Mail Stop: Non Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 under the provisions of 37 CFR 1.10.

Candace White

Candace White

December 5, 2003
Date

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RESPONSE TO RESTRICTION REQUIREMENT IMPOSED IN NOVEMBER 13, 2003 OFFICE ACTION IN U.S. PATENT APPLICATION NO. 09/954,831

Mail Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313

Sir:

In response to the Office Action dated November 13, 2003 in the above-identified patent application, wherein a restriction requirement has been imposed against claims 1-66 as originally filed and pending in the application, between:

Group I claims 1-42 drawn to a CVD precursor;

Group II claims 43-66 drawn to a CVD method.

applicant hereby elect, with traverse, the Group I claims 1-42 drawn to a CVD precursor.

Applicants' reasons for the traversal of the restriction requirement are set out below, and on such basis, applicants request the Examiner to reconsider his restriction of the pending claims, and to withdraw same in favor of consolidated examination and prosecution of claims 1-66 pending in the application.

In the event that the restriction requirement is maintained, request hereby is made by applicants for rejoinder of the composition and method claims under the provisions of M.P.E.P. § 821.04 ("Rejoinder"), upon determination of allowable subject matter directed to the composition aspect of the invention.

An Examiner's authority to require restriction is defined and limited by statute:

> If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are both independent and distinct, 37 C.F.R. §§1.141-142. Without independence and distinctness, a restriction requirement is unauthorized and improper.

In the present application, the species which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement. The claims 1-42 are drawn to a CVD precursor, while the claims 43-66 are drawn to a method in which the CVD precursor comprises a metalloamide precursor. The precursor is specified in method claim 44, depending from independent method claim 43, in terms consistent with the composition claim 1.

Accordingly, these Group I and II claim species cannot be considered "independent" of one another, and are clearly interrelated and interdependent, not "independent and distinct."

The Office Action bases the restriction requirement on the fact that the independent method claim 43 does not require the use of the product specified in the composition claims, but as pointed out above, method claim 44 requires exactly the same compound as recited in claim 1. Further, the Office Action bases the restriction on the contention that the Group I composition may be utilized in a different process, citing the possibility of vaporization of the precursor in the reactor, as opposed to feeding of precursor vapor to the reactor (chemical vapor deposition zone) as required by the Group II claims. Following this line of analysis, no composition claim could ever be immune from a method of use claim/composition claim restriction requirement. The composition of claim 1 could also conceivably be placed into a sealed container, and the sealed container used as ballast for an ocean-going vessel, but such hypothetical possibility does not obscure the fundamental fact that the method claims include recital of a chemical vapor deposition process utilizing a CVD precursor composition, and the composition claims are directed to a CVD precursor composition that is identically claimed in method claim 44, in relation to composition claim 1.

Accordingly, there is appropriate nexus between the composition and method of use claims, they are interrelated to one another, and their relationship is sufficiently close to justify the maintenance of all composition and method claims in the present application for search and examination purposes.

The interdependence of the precursor compositions and the CVD methodology is confirmed - indeed, it is mandated- by virtue of the fact that the description requirements of 35 U.S.C. §112 compel disclosure of both aspects of the invention in the one application that Applicants have filed.

In addition, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one application, as the applicants have done herein. The CCPA has observed:

> We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects as to what they regard as their invention,

regardless of the number of statutory classes involved. In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

This interest is consistent with the practical reality that a sufficiently detailed disclosure supporting claims to one aspect of an invention customarily is sufficient to support claims in the same application to other aspects of the invention.

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of an applicant's financial resources, a practice which arbitrarily imposes restriction requirements may become prohibitive and thereby contravene the constitutional purpose to promote and encourage the progress of science and the useful arts.

It is vital to all applicants that restriction requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner has held to be independent and distinct can be vulnerable to legal challenges alleging double patenting.

The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990) that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement.

Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of patent on the divisional application.

The case of Geneva Pharmaceuticals, Inc., et al. v. Ranbaxy Pharmaceuticals, Inc., et al., No. 02-1439, Federal Circuit, November 21, 2003, further underscores such concerns. There the Court held that § 121 is not a shield against a double patenting challenge if consonance, i.e., a line of

demarcation between the "independent and distinct inventions" that prompted the restriction requirement, is absent.

The Court emphasized that "[t]herefore restriction requirements must provide a clear demarcation between restricted subject matter to allow determination that claims in continuing applications are consonant and therefore deserving of § 121's protections" (02-1439, at page 16).

The Court of Appeals in its decision in Geneva specifically pointed to the applicable requirements imposed on Examiners in issuing restriction requirements:

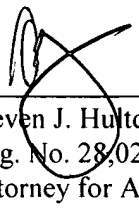
> **"The PTO Manual of Patent Examining Procedure (M.P.E.P.) warns Examiners to apply restriction requirements carefully to avoid issuing two patents to the same (i.e. patentably indistinct) invention:**
>
> > **Since requirements for restriction under 35 U.S.C. 121 are discretionary with the Commissioner, it becomes very important that the practice under the section be carefully administered. Not withstanding the fact that this section of the statue apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE THAT MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION.**
>
> **M.P.E.P. § 803.01 (8th ed. Aug. 2001)."**

The Geneva decision therefore emphasizes the fact that failure to maintain claims consolidated in a single application, as a result of an improper restriction requirement, can result in gross forfeiture of a patent applicant's rights with respect to the various aspects of the invention disclosed in the applicant's specification and claimed in the application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest, the Examiner should not require restriction in cases such as the present application wherein various aspects of a unitary invention are claimed.

For the above reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement and examine all of the aspects of the present invention embodied in claims 1-66.

Respectfully submitted,



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